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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,096	02/07/2001	Hideyuki Iriyama	DAIN:574	4560

7590 12/14/2004

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,096

Applicant(s)

IRIYAMA, HIDEYUKI

Examiner

Lawrence D. Ferguson

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[Signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 8 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Request for Reconsideration

1. This action is in response to the request for reconsideration mailed September 20, 2004. Claims 7, and 12 were amended, claim 4, 6 and 16 were cancelled rendering 5 and 7-13 are pending in this case.

Claim Rejections – 35 USC § 103(a)

2. Claims 9, 10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atake et al (U.S. 6,416,866).

Atake discloses a decorative molding (column 1, lines 5-11 and column 3, lines 6-15) comprising a decorative layer (column 3, lines 45-50) molded by injection molding (column 2, lines 55-60). The decorative molding further comprises a substrate (base sheet) (1), a polyolefin resin formed on the substrate (2), which comprises an acrylic resin binder (column 3, lines 13-50) having a decorative layer (5) between the substrate and surface layer (3) made of polyolefin binding material (column 5, lines 45-65) as depicted in instant Figure 3. Atake discloses the decorative layer comprises acrylic resin and polyvinyl chloride acetate (column 7, lines 19-37). In instant claim 12, the phrase, "composed by graft-copolymerizing" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the

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prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. In claim 1, the phrase, “bonding layer capable of adhering to the injection molded resin molding” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. Although Atake does not explicitly teach a base sheet, one of ordinary skill in the art would recognize the substrate as an equivalent to the instantly claimed base sheet.

3. Claims 5, 7-8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited decorative molding article further including a decorative layer formed on a surface of the base sheet not coated with the bonding layer or a primer layer sandwiched between the decorative layer and bonding layer, where the primer layer contains either an acrylic resin or polyvinyl chloride-acetate resin or both the acrylic resin and polyvinyl chloride-acetate resin. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

Response to Arguments

4. The arguments in regards to rejection under 35 USC 103(a) as being unpatentable over Brooks et al. (U.S. 4,948,654) in view of Matsumoto et al. (U.S. 4,410,595) further in view of Enlow et al. (U.S. 6,336,988) have been considered and the rejection is withdrawn due to Applicants amending claim 12 to include a decorative layer sandwiched between the base sheet and bonding layer, where the decorative layer comprises a binder resin and at least either an acrylic resin or polyvinyl chloride acetate resin.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

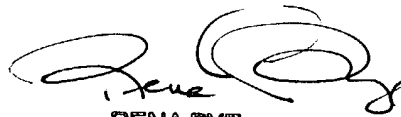
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Lawrence Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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12/10/01